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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,615	03/29/2001	Ervin Dennis Walter	D01615US (1517.002)	4103
91065	7590	05/25/2010		
Epic c/o Boyle Fredrickson S.C. 840 North Plankinton Avenue Milwaukee, WI 53203			EXAMINER RAPILLO, KRISTINE K	
			ART UNIT 3626	PAPER NUMBER
			NOTIFICATION DATE 05/25/2010	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@boylefred.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/821,615	<b>Applicant(s)</b> WALTER ET AL.	
	<b>Examiner</b> KRISTINE K. RAPILLO	<b>Art Unit</b> 3626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 January 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 71-88 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 71-88 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____.                                     |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/25/2002; 2/7/2002; 6/17/2002; 2/3/2003;</u>                 | 6) <input type="checkbox"/> Other: _____.                         |
| <u>2/18/2004; 10/26/2004; 2/14/2005; 4/7/2005.</u>                                     |   |

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## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the Request for Continued Examination (RCE) filed January 15, 2010. Claims 71 – 72, 77 – 78, and 83 – 84 are amended. Claims 1 – 70 were previously cancelled. Claims 71 – 88 are presented for examination.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 15, 2010 has been entered.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 71 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation “an anonymous mode in which the patient is provided with access to the patient sourced medical data in the personal health record database but not data of the clinical medical record when the patient provides basic identification information but is not fully identified” is unclear. If a patient provides basic information, but is not fully identified, how can the patient be in anonymous mode since he is partially identified? In addition, the Examiner is unclear on how providing basic information (i.e. name) lends a patient to not be fully identified.

5. Claims 73 and 79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation “... the registered mode allows healthcare professionals to view selected patient

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sourced data" is unclear. The registered mode, per claim 71, allows a patient, not healthcare provider, access to both medical records and patient sourced records, therefore it is unclear how the healthcare provider is granted access.

6. Claim 71 recites the limitation "a computer-implemented personal health record database holding patient-sourced medical data entered by the patient". There is insufficient antecedent basis for this limitation ("the patient") in the claim.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 71 – 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hacker (U.S. Patent Number 6,988,075) in view of Goldenberg (U.S. Publication Number 2002/0065682 A1) further in view of Segal et al., herein after Segal (U.S. Publication No. 2001/0041991 A1).

In regard to claim 71 (Currently Amended), Hacker teaches a computer system allowing patient-sourced data to be added to a clinical medical record system comprising:

a computer-implemented clinical medical record database created by and accessible to healthcare providers and holding clinical information generated by the healthcare providers during the provision of healthcare (column 7, lines 22 – 24 where Hacker discloses a medical information system and service which stores patient medical records on a database and allows for remote access to the records by medical providers (column 7, lines 22 - 24) which utilizes a web browser to access patient records (column 8, lines 46 - 49). Hacker further discloses patient sourced information where patient medical records may be entered into a system from other sources including patient provided medical information, such as a hard copy of prior medical history (column 6, lines 57 - 60 and column 10, lines 54 - 58). Thus implying a patient medical record is created by and accessible to a health care provider); and

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Hacker also teaches a system operating in one of: (2) a registered mode in which the patient is provided with access to the patient-sourced medical database and read-only access to the data of the clinical medical record when the patient has registered and thus is fully identified (column 8, lines 50 – 57) including machine authentication of the identity of a user based on a prior determination that the user is a patient of the healthcare provider (column 7, lines 43 – 63).

Goldenberg teaches a system operating in (1) an anonymous mode in which the patient is provided with access to the patient-sourced medical data in the personal health record database but not data of the clinical medical record when the patient provides basic identification information but is not fully identified (paragraphs 43 – and 44) where Hacker discloses patient sourced medical data discussed above (Hacker: column 10, lines 54 - 58) and Goldenberg discloses a guest membership, which is interpreted as anonymous, and allows a non-subscriber access to the system. A user is assigned a user ID and password which keep the patient anonymous respective of the levels of access (paragraph [0042]).

Segal teaches a system comprising: a computer-implemented personal health record database holding patient-sourced medical data entered by the patient (Figures 2B and 5A; paragraphs 110, 134, and 143); and a computer-implemented Web portal configured to control access to both of the clinical medical record database and the personal health record database (paragraph 14).

Claim 71 is rejected under 35 U.S.C. 103 as being unpatentable over Hacker and Goldenberg, in view of Segal.

Hacker discloses an electronic medical record system and service for centrally storing patient's medical records electronically on a database for patient controlled remote access by both patients and medical providers.

Goldenberg discloses an interactive network-based health information system which provides up-to-date medical information directly to a user and provides for remote monitoring and diagnosis of the patient and for remote treatment. Various levels of service are provided based on the user being a registered user or authorized guest.

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Segal discloses a method and system for providing a medical record management service that supports the creating, storing, accessing, updating and distributing of patient medical records under the control of a patient and the coordinated care of the patient and his/her physician.

It would have been obvious to one of ordinary skill in the art to include in the electronic medical record system and service of Hacker and the health information system of Goldenberg, the method and system for providing a medical record management service taught by Segal since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination are predictable.

In regard to claim 72 (Currently Amended), Hacker, Goldenberg, and Segal teach the computer system of claim 71. Hacker further teaches a system wherein the registered mode allows integrated access of the personal health record database including the patient-sourced data and data of the clinical medical record database by the patient without re-entry of information from the personal health record database by the patient (column 8, lines 46 – 67) where Hacker discloses access to a patient medical record which includes links to other sections (i.e. different physicians) without re-entering identification and password.

In regard to claim 73 (Previously Presented), Hacker, Goldenberg, and Segal teach the computer system of claim 71. Hacker further teaches a system wherein the Web portal in the registered mode allows healthcare professionals to view selected patient-sourced data flagged by the patient (column 7, line 63 through column 8, line 7).

In regard to claim 74 (Previously Presented), Hacker, Goldenberg, and Segal teach the computer system of claim 71. Hacker further teaches a system wherein in the Web portal in the anonymous mode allows the patient to undertake electronic communication with healthcare professionals (column 10, lines 4 – 33). However, Hacker does not explicitly teach a system which includes an anonymous mode.

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Goldenberg teaches a system including an anonymous mode (paragraphs [0043] and [0044]).

The motivation to combine the teachings of Hacker and Goldenberg is discussed in the rejection of claim 71, and incorporated herein.

In regard to claim 75 (Previously Presented), Hacker, Goldenberg, and Segal teach the computer system of claim 71.

Goldenberg further teaches a system wherein the patient provides a user name and identifying information that is anonymous in nature in the anonymous mode (paragraphs [0043] and [0044]) where a user can be an authorized guest.

The motivation to combine the teachings of Hacker and Goldenberg is discussed in the rejection of claim 71, and incorporated herein.

In regard to claim 76 (Previously Presented), Hacker, Goldenberg, and Segal teach the computer system of claim 71. Hacker further teaches a system wherein the Web portal in the anonymous mode does not permit the patient to make appointments with the healthcare professionals and the Web portal in the registered mode does allow the patient to make appointments with health care professionals (column 6, lines 38 – 40; column 8, lines 25 – 34; and, column 10, lines 4 – 18). Hacker teaches a system for scheduling an appointment via e-mail; because Hackers invention requires registered users to submit an identifier and password, it is inherent that a registered user can schedule appointments with a health care provider.

The limitations of claim 83 (Currently Amended) are the same or similar to the limitations disclosed in claim 71, and are taught by a combination of Hacker, Goldenberg, and Segal as discussed above with the exception of the following limitation: the Web portal including an option to convert to a registered mode wherein the patient-sourced data is incorporated into the clinical medical record when

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the patient has registered and thus is fully identified and wherein the patient is permitted to make appointments and request services of the healthcare providers.

Hacker discloses a web portal to access patient records (column 8, lines 46 - 49) where the patient sourced medical information (column 10, lines 54 - 58 as discussed above) is incorporated into the electronic medical record. Hacker discloses access to electronic medical record is controlled by a server set cookie or patient supplied pass phrase (column 8, lines 55 - 57), which in turn enables a display screen in which a patient gains access to a physician link for web based appointment scheduling (column 9, lines 26 - 32). Thus, Hacker, who discloses web based appointment scheduling discussed above.

Goldenberg discloses non-subscribers access to the system (paragraphs 43 – and 44) where Goldenberg discloses a guest membership, which is interpreted as anonymous, and allows a non-subscriber access to the system. A user is assigned a user ID and password which keep the patient anonymous respective of the levels of access (paragraph [0042]).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made include the function of denying non-subscribers access to web based scheduling as taught by Goldenberg, as Goldenberg discloses various levels of access to a user (paragraphs [0030] through [0038] and paragraph [0042] through [0044]).

Method and system claims 77 – 82 and 83 - 88 repeat the subject matter of system claims 71 - 76. As the underlying processes of claims 71 - 76 have been shown to be fully disclosed by the teachings of Hacker, Goldenberg, and Segal in the above rejections of claims 71 - 76; as such, these limitations (77 - 88) are rejected for the same reasons given above for claims 71 - 76 and incorporated herein.

### ***Response to Arguments***

9. Applicant's arguments filed January 15, 2010 have been fully considered but they are not persuasive. Applicant's arguments will be addressed herein below in the order in which they appear in the response filed January 15, 2010. In response to the Applicant's argument, it is respectfully submitted



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that the Examiner has applied new prior art to the amended claims. The Examiner notes that the amended limitations were not in the previously pending claims; as such, Applicant's remarks with the regard to the application of Hacker, Goldenberg, and Segal are addressed in the above Office Action.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTINE K. RAPILLO whose telephone number is (571)270-3325. The examiner can normally be reached on Monday to Thursday 6:30 am to 3:30 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on 571-272-6787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. K. R./  
Examiner, Art Unit 3626

/Neal R Sereboff/  
Examiner, Art Unit 3626